REMARKS

I. Introduction

Claims 1-46 were pending.

Claims 1, 16, 33, and 40 were rejected under 35 U.S.C. § 112 for failing to define enablement for the invention.*

Claims 1-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stallaert, U.S. Patent No. 6,035,287 ("Stallaert"), in view of Reuters.com, 1996 ("Reuters"), in further view of Bowers, Successful Investing with Fidelity Funds ("Bowers"), and in further view of Nasdaq Liffe Markets ("NQLX"), "the Stallaert-Reuters-Bowers-NQLX Combination."

Applicants have cancelled claims 1-15, 17-23, and 33-46 without prejudice.

Applicants have amended claim 16 and added claims 47-90 to more particularly define the invention. No new matter is being added.

The rejections are respectfully traversed.

II. Summary of the Examiner Interview and New Claims 47-90

The undersigned wishes to thank the Examiner for the courtesies extended during the Personal Interview on January 28, 2004. During the Interview, the Examiner stated that he would further consider an independent claim including the feature of providing the trader with "an exclusive opportunity in trading," as specified in applicants' originally filed claim 22. Nevertheless, the

---

* Although the Office Action refers to "independent claims 1, 16, 35, and 40," claim 35 is a dependent claim of independent claim 33. Applicants therefore believe that the Office Action intended to reject independent claim 33 under 35 U.S.C. § 112.

Examiner stated that he would perform an additional search to ensure that the invention as claimed is allowable. Accordingly, to expedite prosecution of this case, applicants have amended independent claim 16, from which claim 22 depends, to incorporate the subject matter of claim 22, and have cancelled claims 1-15, 17-23, and 33-46 without prejudice.

Applicants have also added independent claims 47, 57, 67, 75, and 83 which all characterize the incentive has providing traders with, an exclusive opportunity in trading." Dependent claims 48-56, 58-66, 68-74, 76-82, and 84-90 have also been added.

III. Applicants' Reply to the Rejections Under § 112

Claim 16 was rejected under 35 U.S.C. § 112, first paragraph, "because the specification does not reasonably provide enablement for the independent claims." See page 4 of the Office Action. The Office Action states that "the specification does not enable any person skilled in the art . . . to the invention commensurate in the scope with these claims." See page 4 of the Office Action [sic]. The Office Action further states that "[t]he ***mechanism for qualification*** must be defined in the independent claims as to how and in what manner the trader may qualify for a discount as to thresholding methods." See Id (emphasis added).

While applicants' claim 16 specifies a method for "determining . . . whether [a] trader qualifies for an incentive," nevertheless, applicants' specification acknowledges that various "mechanisms" may be used to determine whether a trader "qualifies for an incentive." For example, applicants' specification shows that the determination of whether a trader qualifies for an incentive may be based on the size of an order, a trader's credit-worthiness, the price of the trade, the

duration of a transaction, as well as other criteria. See, for example, page, 12, lines 21-29 of applicants' specification.

Applicants' specification also sets forth the following criteria to illustrate the various techniques that may be used for determining whether a trader qualifies for an incentive.

(1) that the trader have sufficient credit acceptability;

(2) that the trader be sponsored by one or more other traders, an exchange, or an exchange's clearing corporation;

(3) that the trader meet certain value levels; and

(4) that the trader satisfy order placement and cancellation levels.

See page 9, line 28 - page 10, line 2 of applicants' specification. Applicants' further specify that the test used to determine whether a trader qualifies for incentives may be dynamically varied, and may be particular to a particular trader or group of traders. See, for example, page 10, line 31 - page 11, line 2 of applicants' specification.

Accordingly, because applicants' specification discloses at least one mechanism for qualifying a trader for an incentive and the mechanism bears a reasonable correlation to the scope of applicants' independent claim 16, applicants respectfully submit that the rejections under 35 U.S.C. § 112 be withdrawn. See *In re Fisher*, 427 F.2d 833, 839; see also MPEP § 2164.01(b).

III. Applicants' Reply to the Rejections Under § 103(a)

Claims 16 and 24-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the

Stallaert-Reuters-Bowers-NQLX Combination. The Office Action states that "it would have been obvious to one skilled in the art at the time of the invention to combine Stallaert in view of Reuters in view of Bowers and further in view of NQLX to teach applicants' disclosure." See page 3 of the Office Action.

However, as applicants previously argued in the Reply to Office Action filed October 27, 2003, Stallaert, Reuters, and Bowers, whether taken alone or in combination, fail to show or suggest "determining . . . whether [a] ***trader*** qualifies for an incentive" as required by applicants' claim 16. Moreover, applicants have amended claim 16 to include the feature of "providing the trader with ***an exclusive opportunity in trading*** if the trader qualifies for the incentive," which is neither shown nor suggested by Stallaert, Reuters, Bowers, or NQLX.* For at least these reasons, the combination of references fails to show or suggest all elements of applicants' claims 16, 47, 57, 67, 75, and 83. The § 103 rejections should therefore be withdrawn. See MPEP §§ 2142 and 2143.

Moreover, the Office Action relies on NQLX in an attempt to provide the requisite objective motivation to combine Stallaert, Reuters, and Bowers. The Examiner contends that page 2-A of NQLX provides "motivation to teach electronic block online trading which possess economies of scale through incentivising [sic] the market makers" See pages 3-4 of the Office Action. However, because NQLX was published in 2002 (as indicated by the copyright information in the lower margin of the reference), NQLX does not qualify as prior art under 35

---

* During the January 28, 2004 Examiner Interview, the Examiner appeared to agree that the references of record fail to show or suggest this element of applicants' claims.

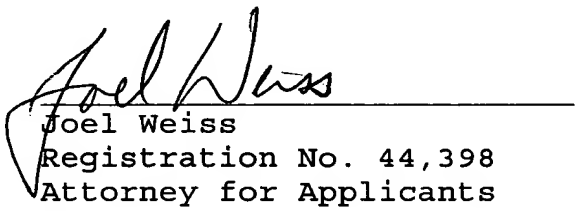
U.S.C. § 103 because the date of publication is not ***prior*** to applicants' effective filing date of June 14, 2000. NQLX therefore does not qualify as prior art under 35 U.S.C. § 103 and the § 103 rejections by way of Stallaert-Reuters-Bowers-NQLX Combination must be withdrawn.

V. Conclusion

Because independent claims 47, 57, 67, 75 and 83 also include a limitation related to "an exclusive opportunity in trading", therefore claims 47, 57, 67, 75 and 83 are patentable as well. Furthermore, dependent claims 24-32, 48-56, 58-66, 68-74, 76-82 and 84-70, which depend, either directly or indirectly from independent claims 47, 57, 67, 75 and 83, are allowable as well.

The foregoing demonstrates that applicants' claims 16, 24-32, and 47-90 are patentable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully Submitted,



Joel Weiss
Registration No. 44,398
Attorney for Applicants
Fish & Neave
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000